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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,996	04/05/2002	Tatsuji Nagaoka	9683/112	5819

7590 06/27/2007
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P O Box 10395
Chicago, IL 60610

EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/089,996	Applicant(s) NAGAOKA ET AL.	
	Examiner Khanh H. Le	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-43, 45, 46 and 48-55 is/are pending in the application.
- 4a) Of the above claim(s) 21-23, 31-43, 45, 46, 48-53 and 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20, 24-30 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/20/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/26/2007 has been entered.
2. Claims 18-43, 45-46, 48-55 are pending. Applicants have amended claims 18-23, and 25. Claims 21, 22-23, 31-43, 45-46, 48-53, 55 are withdrawn. Thus claims 18, 19, 20, 24-30, 54 are now examined. Of these, claim 18 is independent.

Claim Rejections - 35 USC § 112 Second Paragraph

3. **Rejection of Claim 26 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn**, following the interpretation suggested by Applicants at Response page 8, 3rd full paragraph.

For prior art application, the Examiner accepts Applicants interpretation of "a request requesting the service facility to render the promoted service" as reading on coupon data or incentive information.

Claim Rejections - 35 USC § 112

4. **Rejection of Claim 26 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn** for the same reasons as above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 18, 19, 20, 24, 26-29, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Holman, US 5,287,181.

Holman discloses (independent claim 18):

A mobile terminal (home unit for extracting e-coupon from TV signals: see abstract, Figures 1, 2 and associated text) for use in a broadcasting system, comprising a broadcast station (col. 6 lines 5-27), the mobile terminal comprising:

interactive device interface specifically configured to communicate with an interactive device (Figure 1 items 33, 10 or 40; Fig 2: the interactive device being a cable box, TV, or VCR, col. 5 lines 9-12) for receiving broadcast information from the broadcast station;

interactive device control (Fig 3 items 43, 150, 117: system of home unit including remote control and/or keypad and control unit described in detail in Figure 4) configured to instruct the interactive device via the interactive device interface to control reception and reproduction of the broadcast information by the interactive device and forwarding of selected information in the broadcast information to the mobile terminal from the interactive device (see abstract, Figures 1, 2 and associated text);

request generator (e.g. Fig 3 items 43, 150, remote control and/or keypad and components, e.g. Figure 4, items 151, 205) configured to generate a user request for incentive information (e.g. Figure 4 item 207: "view" coupon request) for promoting a service found in the broadcast information;

request sender (e.g. Fig 3 items 43, 150, remote control and/or keypad and components, e.g. Figure 4, items 151, 205) configured to transmit the user request for incentive information wherein the user request which is receivable by a management system (e.g. Figure 3 item 117: the management system being the control circuit, described in detail in Figure 4 and associated text);

incentive information receiver (e.g. Fig 3 item 128: memory in home unit; col. 6 lines 24-27; col. 10 lines 45-48) configured to so that the mobile terminal receives the incentive information returned from the management system;

incentive information storage (Fig 3 item 128: memory in home unit; col. 6 lines 24-27; col 10 lines 45-48) configured to store the incentive information returned from the management system;

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mobile communication network interface configured to communicate via a mobile communication network with a service facility that provides the service (col. 4 lines 39-47);

and

incentive information presenter (col. 4 lines 58-68; col. 11 lines 17-22; mag cards or the like) configured to present the stored incentive information to the service facility in order to receive the promoted service from the service facility (col. 4 lines 39-47);.

Holman also discloses the following dependent claims:

19, 20, 54: user request sent and incentive information received via the interactive device (col. 6 lines 5-27).

24: a memory for storing personal information, wherein the personal information is communicated to the management system, along with the user request (col. 14 lines 11-17);

26 and 27: the incentive information comprises a request to render a service (the request is interpreted as a coupon as suggested by applicants) or a redeemable promotion (abstract: e-coupon);

29: the incentive information presenter communicates at least a part of the incentive information to the service facility via the mobile communication network (col. 4 lines 39-47);

28: the user request comprises a qualification for the user to receive the incentive information (col. 13 line 40 to col. 14 line 2).

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. **Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holman as applied to claim 18 above, and further in view of Official Notice.**

Holman does not disclose (dependent claim 25) wherein the user request comprises a form to be filled with information by a user, and the user interface comprises a keypad for inputting data into the form. However Holman discloses a form filled out by a user to subscribe to the coupon service based on which a subscription data card is generated (col. 16

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lines 44-60) for inputting user data into the e-coupon system that is periodically updated (col. 17 lines 7-9).

Because Holman suggests other electronic means instead of the subscription data card for inputting consumer data into the system are possible alternatives (col. 16 lines 49-50), and because input of data via remote control is known at the time of the invention, it would have been obvious to one skilled in the art at the time the invention was made to modify Holman's system with inputting user data via a keypad.

9. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holman as applied to claim 18 above, and further in view of Freeman et al. US 6450407.

Holman does not disclose (dependent claim 30) the interactive device comprises a set-top box, and the interactive device interface comprises a set-top box interface.

However Freeman, in a similar e-coupon on chip cards scheme, discloses a set top box is an alternate device to a television or other consumer devices as conduits for delivering e-coupons (abstract, col. 10 lines 7-22). Thus it would have been obvious to one skilled in the art at the time the invention was made to replace Holman's television with an STB as alternate delivery device as taught by Freeman.

Response to Arguments

10. Applicant's arguments with respect to claims 18, 19, 20, 24-30, 54 have been considered. Applicants are correct as to Meyer not disclosing local coupon storage. Thus the new ground(s) of rejection are presented above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Newnam US 2002/0133405, discloses coupons and incentives relating to broadcast content, whether provided over the television, internet, or other means, provides messages that can be transmitted to different types of user devices, including personal computers, playback personal recorders, set top boxes, net top boxes, and wireless clients.

Sheehan US 2002/0178060 discloses providing and redeeming electronic paperless coupons via a variety of devices, including televisions, set-top boxes, personal computers (PCs).

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Conkwright et al. US 7146329 B2 discloses individually targeted content to ~~set top~~ box.

Eldering US 7150030 discloses targeted content in broadcast stream, selection by user via STB's or television via remote control, system buttons or keyboard (FIG. 2), monitoring of activities, saving locally; user control of data for sale to 3rd parties

Williams et al., US 6075971 A discloses targeted coupons downloaded to a user's system, including STB's, automatically or on demand, in limited numbers ; use of coupons monitored.

***Classen US 6069672** discloses remote control for receiver.

***Goldstein 5410326** discloses STB system

* supplied by IDS

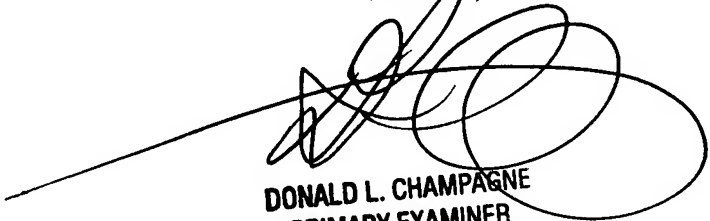
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 14, 2007

KHL



DONALD L. CHAMPAGNE
PRIMARY EXAMINER